UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,018	11/25/2003	Masanobu Nishimaki	280A 3421-CIP-11	7002

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ART UNIT	PAPER NUMBER
3694	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/722,018	NISHIMAKI, MASANOBU
	Examiner	Art Unit	
	SCOTT S. TROTTER	3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>27 April 2009</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-19 and 23-36</u> is/are pending in the application.

    4a) Of the above claim(s) <u>1-7,16,17 and 23-35</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>8-15,18,19 and 36</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Status of the Claims

1.   This action is in response to the response filed on April 27, 2009. Claims 8-15,

18, 19, and 36 are pending and examined. Claims 20-22 are canceled. Claims 1-7, 16,

17, and 23-35 are withdrawn.

Information Disclosure Statement

2.   Applicant's IDS filed April 27, 2009 has been entered with an initialed copy

attached to this office action.

Response to Arguments

3.   Applicant's arguments filed April 27, 2009 have been fully considered but they

were not persuasive. It is hoped that the added claim interpretation will make clear the

difference between the prior art and the invention. The "measure" of something is its

value based on the arguments we think that what is intended is the "type of

measurement" since the arguments were not aimed at the broadest reasonable

interpretation there is not much further to say about them but claim 36 is a good

indicator of what the rejection would have looked like so counter arguments can be

made if that is the focus of the invention.

Claim Interpretation

4.   A capital raiser is someone who is selling something. A capital management

order is an order to buy something. Here is the examiner's interpretation of what each

point in claim 8 means.

I. There is some kind of electronic exchange for orders.

II. X desires to sell A.

III. A is composed of B + C.

IV. Y wants to buy B.

V. Z wants to buy C.

VI.i. The price X is asking for A is XA.

VI.ii. the price Y is offering to buy B is YB.

VI.iii. the price Z is offering to buy C is ZC.

Then 'a' and 'b' are matching orders when XA <= YB + ZC.

5.   Here is the examiner's interpretation of what each point in claim 9 means.

I. There is some kind of electronic exchange for orders.

II. X desires to sell B.

III. Y desires to sell C.

IV. A is composed of B + C.

V. Z wants to buy A.

VI.i. The price X is asking for B is XB.

VI.ii. the price Y is asking for C is YC.

VI.iii. the price Z is offering to buy A is ZA.

Then 'a' and 'b' are matching orders when ZA >= XB + YC.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

    A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the
United States before the invention thereof by the applicant for patent, or on an international application
by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this
title before the invention thereof by the applicant for patent.

7.   Claims 8, 9, 18, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated

by Stallaert et al (U.S. Patent 7,124,106 B1 hereafter Stallaert).

As per claim 8 Stallaert teaches:

A financial transaction server for supporting a financial transaction executed by a

plurality of client terminals of users including a prospective capital raiser that desires to

perform capital raising and a plurality of prospective capital managers that desire to

perform capital management,

wherein:

(I) the financial transaction server is connected to a financial transaction database

storing data regarding financial transactions and to each of the plurality of client

terminals; (*see Figure 7*. The bundle trading processor is the server, the limit order

table is the database, the web client represents the client terminals.)

(II) a prospective capital raiser X desires to perform capital raising by means of a

financial instrument A; (*see abstract*. Exchanging assets includes selling financial

instruments to raise capital.)

(III) the financial instrument A can be unbundled into at least a constituent B and a

constituent C; (*see column 2 lines 47-54*. Recombining assets inherently includes

unbundling them from their original bundles so they can be recombined.)

(IV) a prospective capital manager Y desires to perform capital management by means of the constituent B; (*see abstract.* Exchanging assets includes buying financial instruments to invest capital.)

(V) a prospective capital manager Z desires to perform capital management by means of the constituent C; (*see abstract.* Exchanging assets includes buying financial instruments to invest capital. *see column 1 line 18-column 2 line 61, that it applies to securities see column 2 lines 31-44*) and

(VI) (i) a capital raising order x is stored in the financial transaction database, the capital raising order x being sent from a client terminal of the prospective capital raiser X, and having order information specified by the client terminal that includes a desired capital raising numerical value XA on the financial instrument A; (*see column 2 lines 65-column 3 line 1.* The bundle to be acquired is the price of the bundle being sought to be disposed of. *See column 1 lines 56-59.* Assets to be traded include money)

(ii) a capital management order y is stored in the financial transaction database, the capital management order v being sent from a client terminal of the prospective capital manager Y, and having order information specified by the client terminal that includes a desired capital management numerical value YB on the constituent B: (*see column 1 line 18-column 2 line 61, that it applies to securities see column 2 lines 31-44*) and

(iii) a capital management order z is stored in the financial transaction database, the capital management order z being sent from a client terminal of the prospective capital

manager Z, and having order information specified by the client terminal that includes a

desired capital management numerical value ZC on the constituent C, and

wherein said financial transaction server:

(a) compares the capital raising order x, the capital management order y and the capital

management order z as objects of matching in the financial transaction database,

adjusts, in a case where a disagreement exists between a measure of the desired

capital raising numerical value XA, a measure of the desired capital management

numerical value YB and a measure of the desired capital management numerical value

ZC,

the measure of at least any one of the desired capital raising numerical value XA, the

desired capital management numerical value YB and the desired capital management

numerical value ZC, for the pertinent desired numerical value or values, and then

determines whether or not a match exists between:

(1) the desired capital raising numerical value XA; and

(2) the desired capital management numerical value YB and the desired capital

management numerical value ZC; and

(b) executes the financial transaction between the capital raising order x, the capital

management order Y and the capital management order z in a case where it is

determined that the match exists. (*see at least column 2 lines 47-61 and column 3 lines

15-42.* Recombining assets is the taking of assets being disposed from different

bundles to meet the bundle acquires needs. The system matches trades when the net

valuation of the assets given by the acquirers is greater than or equal to the net

valuation of the assets given by the sellers.)

As per claim 9 Stallaert teaches:

A financial transaction server for supporting a financial transaction executed by a

plurality of client terminals of users including a plurality of prospective capital raisers

that desire to perform capital raising and a prospective capital manager that desires to

perform capital management, wherein:

(I) the financial transaction server is connected to a financial transaction database

storing data regarding financial transactions and to each of the plurality of client

terminals; (*see Figure 7. The bundle trading processor is the server, the limit order*

table is the database, the web client represents the client terminals.)

(II) a prospective capital raiser X desires to perform capital raising by means of a

financial instrument B; (*see abstract. Exchanging assets includes selling financial*

instruments to raise capital.)

(III) a prospective capital raiser Y desires to perform capital raising by means of a

financial instrument C; (*see abstract. Exchanging assets includes selling financial*

instruments to raise capital.)

(IV) at least the financial instrument B and the financial instrument C can be bundled

into a hybrid product A; (*see column 2 lines 47-54. Recombining assets includes*

bundling them into their desired bundles.)

(V) a prospective capital manager Z desires to perform capital management by means

of the hybrid product A; (*see at least column 1 line 18-column 2 line 61, that it applies to*

securities see column 2 lines 31-44 and see abstract. Exchanging assets includes

buying financial instruments to invest capital.) and

(VI) (i) a capital raising order x is stored in the financial transaction database, the capital

raising order x being sent from a client terminal of the prospective capital raiser X, and

having order information specified by the client terminal 'that includes a desired capital

raising numerical value XB on the financial instrument B; (*see column 2 lines 65-column*

3 line 1. The bundle to be acquired is the price of the bundle being sought to be

disposed of. *See column 1 lines 56-59.* Assets to be traded include money)

(ii) a capital raising order y is stored in the financial transaction database, the capital

raising order y being sent from a client terminal of the prospective capital raiser Y, and

having order information specified by the client terminal that includes a desired capital

raising numerical value YC on the financial instrument C; (*see column 1 line 18-column*

2 line 61, that it applies to securities see column 2 lines 31-44) and

(iii) a capital management order z is stored in the financial transaction database, the

capital management order z being sent from a client terminal of the prospective capital

manager Z, and having order information specified by the client terminal that includes a

desired capital management numerical value ZA on the hybrid product A. and wherein

said financial transaction server:

(a) compares the capital raising order x, the capital raising order Y and the capital

management order z as objects of matching in the financial transaction database,

adjusts, in a case where a disagreement exists between a measure of the desired

capital raising numerical value XB, a measure of the desired capital management

numerical value YC and a measure of the desired capital management numerical value

ZA,

the measure of at least any one of the desired capital raising numerical value XB, the

desired capital management numerical value YC and the desired capital management

numerical value ZA, for the pertinent desired numerical value or values, and then

determines whether or not a match exists between:

(1) the desired capital raising numerical value VB and the desired capital raising

numerical value VC; and

(2) the desired capital management numerical value ZA; and

　　　(b) executes the financial transaction between the capital raising order x, the

capital raising order y and the capital management order z in a case where it is

determined that the match exists. (*see at least column 2 lines 47-61 and column 3 lines

15-42*. Recombining assets is the taking of assets being disposed from different

bundles to meet the bundle acquires needs. The system matches trades when the net

valuation of the assets given by the acquirers is greater than or equal to the net

valuation of the assets given by the sellers.)

　　　As per claims 18 and 19 Stallaert teaches the trading of equities and other

assets. (*see column 1 lines 55-59 and column 2 lines 30-35*)

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been obvious
> at the time the invention was made to a person having ordinary skill in the art to which said
> subject matter pertains. Patentability shall not be negatived by the manner in which the invention
> was made.

9.   Claims 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Stallaert in view of Silverman et al. (U.S. Patent 5,924,082 hereafter Silverman).

As per claim 10 while Stallaert does not specifically address negotiated

transactions establishing contact between the two parties to the transaction for

negotiating the orders Silverman taught negotiating the orders to other terminals to give

them the chance to negotiate over the proffered terms making a trade. (*see Silverman

abstract*) Therefore it would have been obvious to a person of ordinary skill in the art at

the time the invention was made to disclose the bids to other terminals to encourage

trading.

10.   Claims 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Stallaert in view of Shkedy (U.S. Patent 6,236,972 B1) and Official Notice.

While Stallaert does not explicitly address providing self introduction materials or

proposal information the information o the bundles available would qualify as capital

management reference data. Shkedy teaches storing the prospectuses (*see Shkedy

column 10 lines 1-2*) which would qualify as the capital raiser introduction and the

proposal. Official Notice is taken that it is old and well known in the art of finance for

investors to have introducing materials historically a letter of introduction from a rich

noble evolved into a letter of credit from a bank to signify that an individual had the

capital to complete a bigger deal than their cash on hand would indicate. Therefore it

would have been obvious to a person of ordinary skill in the art of raising capital to have

references describing the assets and liabilities being traded and those doing the trading

to make sure that they can meet the obligations the are creating.

11.   Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Stallaert in view of Official Notice.

As per claims 11-14 while Stallaert does not specifically address settlement it is

old and well known in the art of electronic trading to store settlement information in a

database that includes funds account numbers, fund account balances, and margin

requirements. An obvious examples are E*trade and Instinet (*see column 1 lines 18-*

30) but any electronic brokerage would require such a settlement system to complete

trades (a cited example is Shkedy column 10 which may be evidentiary support for

settlement). Stallaert does include database tracking each bundle and does notify each

bidder when their bundle is traded. Therefore it would have been obvious to a user of

ordinary skill in the art at the time the invention was made to include a settlement

system to finalize trades made on the system.

12.   Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stallaert

in view of Ross (Fundamentals of Corporate Finance Third edition, 1995).

As per claim 36 Stallaert teaches the server of claims 8 and 9 but does not

explicitly teach converting between measures. Ross teaches such tools as a standard

tool in finance. Converting between different kinds of interest rate quotes is required to

compare them. *See Ross pages 140-146* Therefore it would have been obvious to a

person of ordinary skill in the art at the time the invention was made to convert any

measurement to a common unit so that assets could be compared to each other when

deciding what to offer to pay for the assets.

Conclusion

13.   Any inquiry concerning this communication from the examiner should be directed

to Scott S. Trotter, whose telephone number is 571-272-7366. The examiner can

normally be reached on 8:30 AM – 5:00 PM, M-F.

14.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James P. Trammell, can be reached on 571-272-6712.

15.   Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system, see http://pair-direct.uspto.gov.

Should you have questions on access to the Private PAIR system, contact the

Electronic Business Center (EBC) at 866-217-9197 (toll-free).

16.   The fax phone number for the organization where this application or proceeding

is assigned are as follows:

(571) 273-8300   (Official Communications; including After Final

Communications labeled "BOX AF")

(571) 273-6705   (Draft Communications)

sst
7/21/2009

/James P Trammell/
Supervisory Patent Examiner, Art Unit 3694